

Application No.: 09/899,066  
Art Unit 2615

Attorney Docket No. 0630-1287P  
Reply to December 23, 2004 Office Action  
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REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-28 are now present in this application. Claims 1, 11, 21 and 26-28 are independent.

An amendment has been made to the specification.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. §119

Applicants thank the Examiner for correctly acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document on the Form PTO-326.

Specification Objection

The Examiner has objected to the specification because of one informality. In order to overcome this objection, Applicants have amended the specification in order to correct the deficiency pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-5, 9, 11-13, 17 and 26-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 6,046,863 to Chino. This rejection, presented in the previous Office Action regarding claims 1-5, 9, 11-13 and 17 and specifically "maintained" in the outstanding Office Action, is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.

A rejection must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Beis is directed to an optical monitoring system having a video camera with a first sensing unit to produce black and white images and a second sensing unit for producing color images. See the abstract of Beis, in this regard. When the incoming light is in a range below a certain threshold, Beis activates the black and white sensing means and deactivates the color sensing means

and, when the incoming light is in a range above the threshold, Beis activates the color sensing means and deactivates the black and white sensing means. See the claims of Beis in this regard. Beis discloses a single lens element or objective 1.

The Office Action clearly admits that Beis does not disclose the details of its lens system.

Applicant respectfully submits that not only does Beis not disclose the details of its lens system, but Beis also does not disclose any control movement of its lens in general, let alone in accordance with the photographing mode set on the basis of comparing the detected illumination with a reference illumination, as recited, or by loading corresponding pre-stored trace data of the lens, also as recited.

To remedy these deficiencies, the Office Action turns to Chino.

Chino discloses a digital video cassette recorder (VCR) that has a zoom lens and an auto-focus mechanism that maintains the image in focus while the lens is zoomed. See Col. 1, lines 13-20, for example. Chino's invention is directed to a VCR that inserts a neutral density (ND) filter into and removes the neutral density filter from the optical path of its zoom lens – see col. 4, lines 28-33. Chino discloses that when the ND filter is inserted into, or removed from, the optical path of its zoom lens, the lens goes out of focus – see col. 4, lines 53-61, for example.

Chino's invention is directed to eliminating the out-of-focus problem that is caused by insertion and/or removal of a neutral density filter from his VCR zoom lens path – see, for example, cols. 5-8 and Chino's claims.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements

about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembiczkak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made.

However, these inquiries are not found in the Office Action with respect to independent Claim 1.

This rejection of claims 1-5, 9, 11-13, 17 and 26-27 primarily responds to arguments raised by Applicant in the remarks portion of the Amendment filed on July 19, 2005. Based on the tenor of the responses, it appears that the previously stated (in the rejection mailed April 22, 2004) grounds of rejection of claims 1-5, 9, 11-13 and 17 are being repeated and applied to those claims and to apparatus claims 26 and 27 (that correspond to method claims 1 and 11).

Applicant's undersigned representative contacted Examiner Jelinek on March 1, 2005 and Examiner Jelinek kindly stated that he appreciated Applicant's concerns and confirmed that the rationale of the previous rejection was being repeated in the outstanding Office Action.

Under the circumstances, Applicant will traverse this rejection for the reasons presented below.

The Office Action concludes that it would be obvious to modify Beis with the zoom lens of Chino to use the zoom lens of Chino to provide detailed images of far away objects. The rationale for this is the allegedly well known ability of a zoom lens to allow distant objects to be imaged and the unsupported conclusion that providing a zoom lens for Beis would enhance its surveillance function.

Going even further, the Office Action speculatively asserts that the zoom capability provided by Chino would operate with the set photographing mode because zooming would take place in both modes.

Applicant respectfully submits that the Office Action fails to meet its burden of demonstrating proper motivation for one of ordinary skill in the art to modify Beis as proposed.

First, the Office Action does not correctly address the fact that Beis and Chino are concerned with distinctly different problems, and that they function differently. Beis discloses a surveillance camera with a fixed lens that is not adjusted and cannot zoom, and contains no disclosure or suggestion of using a zoom lens system or a zoom lens system with autofocus or a system that uses a neutral density filter that upsets autofocus.

*In response to this previously presented argument, the Office Action alleges that Applicant is arguing that Beis and Chino are non-analogous art. This is not true. All that Applicants alleged is that Beis and Chino are concerned with distinctly different problems. The Office Action indicates that both references are concerned with inserting and removing a filter from an optical path. Applicant responds to this by stating that so are almost all photographic optical systems and this characteristic alone is nothing more than a broad general teaching of almost any photographic system that does not constitute evidence of proper motivation to modify Beis in view of Chino, as noted in Dembcizak, cited above. The Office Action notes that Chino teaches a zoom lens that compensates an out-of-focus condition caused by the insertion or removal of an optical filter. However, Beis does not share this feature in common with Chino because Beis*

*has no autofocus system or a zoom lens. Thus, this is not a shared feature of both references.*

*The Office Action also states that in no way does the previous Office Action suggest supplanting the optical filter of Beis with a neutral density filter and that it is clear that the zoom lens of Chino would function in harmony with the optical filter of Beis.*

*Applicant respectfully submits that this admission in the Office Action further teaches away from the proposed modification of Beis by Chino because each reference discloses the use of only a single filter. There is no teaching in either reference of using two filters, especially of one uses a zoom lens in Beis instead of the Beis fixed focus lens.*

Second, Chino contains no disclosure of (1) a surveillance camera, (2) how to identify an object of interest to zoom in on or away from in a surveillance operation; (3) how to track an object of interest to zoom in on or zoom away from in a surveillance operation.

Third, the Office Action fails to provide objective evidence that one of ordinary skill in the art would desire to modify a fixed focus surveillance camera like that of Beis with a sophisticated autofocus zoom lens system incorporating a neutral density filter.

As pointed out above, the mere fact that these two references may be combined in some way does not make the modification obvious unless the prior

art suggested the desirability of the modification.

*Applicant respectfully submits that the Office Action does not specifically address these three previous paragraphs, all of which were presented in the Amendment filed July 19, 2004, thereby failing to comply with the explicit requirement of MPEP 707.07(f) to respond on the merits to each ground of traversal of the rejection.*

All that is presented in terms of motivation is the alleged desirability of providing detailed images of far away objects. However, this statement is nothing more than a broad, conclusory speculative statement that, standing alone, is not evidence of motivation to modify Beis and provide a Beis with a zoom lens having autofocus characteristics and a neutral density filter. See In re Dembiczak, cited above, in this regard.

Moreover, even if these references were combined as suggested, they would not result in the claimed invention because Beis does not control movement of its lens at all and there would be no incentive to move the newly applied Beis-Chino zoom lens in accordance with the set (b/w or color detection) photographing mode. The only incentive to control movement of the Beis-Chino zoom lens would be when the lens goes out of focus, but this is not what is claimed.

*In response to this argument, the Office Action states that it is well known to provide a video camera having a variable focal length to permit selective*

*magnification of the image captured by the camera, thereby allowing the operation of the camera to zoom in on an object of interest, and when video cameras are employed in security surveillance systems, it is often desirable that the zoom condition of the camera be changed very rapidly, either to zoom in on a scene of interest in the event of an alarm or the like, or to make a rapid transition from one scene to another in a predetermined sequence of surveillance scenes.*

*Applicant respectfully submits that this entire argument in the outstanding Office Action is speculation unsupported by objective factual evidence. As noted in In re Lee, cited above, on page 5 of this Reply, a rejection must be based on objective evidence of record, not merely conclusory statements of the Examiner. This argument is not supported by any objective factual evidence and, therefore, cannot be given any weight in establishing a prima facie case of obviousness of the claimed invention.*

Furthermore, with respect to claim 11, there is no disclosure in either applied reference of correlating first trace data to a daylight mode and second trace data to nighttime mode. Presumably, Chino's zoom lens goes in and out of focus only when a neutral density filter is inserted into or removed from the lens path, and there is no disclosure of relating the insertion and/or removal of the neutral density filter to operation in a daytime or nighttime mode, and Beis doesn't even address the issue of using a neutral density filter. In short, there is absolutely no disclosure in either reference of the relationship of the first

trace data to a daylight mode and second trace data to nighttime mode or of controlling movement of a lens on the basis of the recited first and second trace data.

*The Office Action's response to this previously presented argument effectively is that both Beis and Chino insert a filter in an optical path and both Beis and Chino remove a filter from an optical path and is based on substituting Chino's variable focus zoom lens for Chino's fixed focus lens. As noted above, with reference to the "Dembczak" decision, simply because both Beis and Chino use a filter does not constitute specific objective factual evidence of proper motivation to replace Beis' fixed focus lens with Chino's variable focus zoom lens. Perhaps hundreds of thousands of camera references employ filters. That fact alone does not mean that one of ordinary skill in the art would be motivated to combine all of those references. Moreover, because of the significant differences between these two references, which are pointed out in detail above, one of ordinary skill in the art would not be motivated to modify Beis in view of Chino, as suggested.*

Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither applied reference even suggests controlling movement of a lens in accordance with a photographing mode set on the basis of comparing

detected illumination with a reference illumination value by loading pre-stored lens trace data, and with respect to claim 11, first trace data with respect to a daylight mode and second trace data with respect to a nighttime mode, the motivation for modifying Beis to include such a feature must be based on speculation and/or impermissible hindsight.

Accordingly, this Office Action fails to make out a *prima facie* case of proper motivation to combine these references in the manner suggested, and therefore fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1-5, 9, 11-13, 17 and 26-27 is respectfully requested.

Claims 6-8, 10, 14-16 and 18-25 stand rejected under 35 U.S.C. §103(a) as unpatentable over Beis in view of Chino, and further in view of U.S. Patent 5,959,669 to Mizoguchi. This rejection, presented in the previous Office Action and specifically "maintained" in the outstanding Office Action, is respectfully traversed.

First, the Beis-Chino reference combination is improper for the reasons stated above and those reasons are incorporated herein by reference.

Second, Beis does not disclose a need for an OLPF. As pointed out in the rejection, with reference 4 to Beis, 6, lines 33-39, Beis uses a simple infrared

cutoff filter. An infrared filter cuts off (absorbs) infrared radiation and passes visible light. Beis' infrared filter cuts off (absorbs) just the high (infrared) frequencies, while passing the visible frequencies. Without a showing of a need for an OLPF, there is no need to even consider the Mizoguchi reference. Beis discloses no need for such a filter and the Officer Action fails to present objective evidence of such a need.

*In response to this previously presented argument, the Office Action states that Mizoguchi provides clear motivation for (1) providing an OLPF when photographing color in order to eliminate false color and (2) not using a OLPF when photographing in black and white, which involves no false color, in order to realize high resolution (col. 1, lines 40-55). Applicant respectfully disagrees with this characterization of Mizoguchi. In col. 1, lines 40-55, Mizoguchi actually teaches that, when photographing in black and white, one may either remove an lpf or use an lpf depending on the spatial transmission frequency spectrum of the lpf. In other words, Mizoguchi actually teaches using an lpf for color or black and white photography, depending one the spatial frequency characteristics of the lpf.*

Applicants respectfully point out that merely because the prior art can be modified in the manner suggested by the Examiner does not render the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir, 1992).

Moreover, Mizoguchi is concerned with different issues than are Beis and Chino. Beis is concerned with photographing documents (col. 1, lines 35-55) and uses different crystal low pass filters depending on the resolution employed – see col. 3, lines 5-40, for example. Whereas Beis is concerned with surveillance using a fixed focus lens 1, and Chino is interested in maintaining autofocus in a zoom lens system when the system becomes out of focus due to insertion or removal of a neutral density filter in the path of the zoom lens. Mizoguchi is directed to imaging different objects with different characteristics than either Beis or Chino. For example, Beis does not disclose that it is carrying out surveillance on documents with different resolutions.

*In response to this previously presented argument, the Office Action again mischaracterizes Applicant's argument as a non-analogous art argument. The Office Action also alleges that the teaching of Mizoguchi is reasonably pertinent to the particular problem to which the applicant was concerned because Mizoguchi teaches how an OLFP can be used in a day-night camera for optimal resolution and false color suppression of the black-and-white and color photographing. Applicant respectfully disagrees with this characterization of Mizoguchi.*

*Mizoguchi never once mentions day-night photographing. Mizoguchi only mentions low pass filters in connection with black and white photography and the only example of this that is given is black and white photography of a document. In fact, a computerized word search on "uspto.gov" of Mizoguchi*

*reveals no mention of “night” and the only mention of “day” is found in col. 19, lines 51-61 and has nothing to do with day-night photography.*

*This alleged teaching in Mizoguchi of how an OLPF can be used in a day-night camera is simply not found in Mizoguchi and reflects the impermissible hindsight (based solely on Applicant’s disclosure) present in this rejection.*

There is no objective evidence of record that would provide proper motivation for one of ordinary skill in the art to turn to the high resolution document camera art that employs a crystal low pass filter designed to reduce or eliminate an aliasing distortion or color moiré in Beis’ system, which has no indication that it has such problems. Moreover, Chino does not disclose that it has the problems that are addressed by Mizoguchi.

This is persuasive evidence that the rejection is based on improper hindsight reconstruction of Applicant’s invention based solely on Applicant’s disclosure and on the improper practice of picking and choosing individual references to combine without any proper motivation to do so absent solely following Applicant’s disclosure to achieve the claimed invention.

The Office Action is picking and choosing references that are not concerned with the same issues and combining them in a completely arbitrary manner based solely on Applicant’s disclosure in a completely improper hindsight manner.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to combine these references in the manner suggested, and therefore fails to make out a *prima facie* case of obviousness of the claimed invention.

Further, with respect to claim 21, there is no disclosure in either applied reference of relating first trace data to a daylight mode and second trace data to a nighttime mode. Presumably, Chino's zoom lens goes in and out of focus only when a neutral density filter is inserted into or removed from the lens path, and there is no disclosure of relating the insertion and/or removal of the neutral density filter to operation in a daytime or nighttime mode, and Beis doesn't even address the issue of using a neutral density filter. In short, there is absolutely no disclosure in either reference of the relationship of the first trace data to a daylight mode and second trace data to a nighttime mode or of controlling movement of a lens on the basis of the recited first and second trace data.

Reconsideration and withdrawal of this rejection of claims 6-8, 10, 14-16 and 18-25 is respectfully requested.

New Rejections under 35 U.S.C. § 103

In addition to maintaining the previous rejections, the Office Action presents new rejections of the claims, as amended. The Office Action states that

Applicant's amendment necessitated the new grounds of rejection. Applicant respectfully disagrees with this conclusion, however, because the only changes to the claims were made to provide proper antecedent basis for terms in the amended claims. The previous Office Action objected to a number of claims for lack of proper antecedent basis regarding certain claim terms. Based on this objection, Applicant reviewed the claims and amended a number of claims to provide proper antecedent basis for terms recited therein. For example, claim 1 was amended to provide proper antecedent basis for terms such as "photographing mode" and "pre-storing trace": and "comparing the detected illumination with a reference illumination value," all of which terms are found in claim 1 as originally filed.

Similar comments apply to amended claim 4, which provides proper antecedent basis for the terminology "pre-stored first trace data" and "pre-stored second trace data."

Similar comments apply to amended claim 9, which provides proper antecedent basis for "control unit."

Similar comments apply to amended claims 11 and 21, which provide proper antecedent basis for "a daytime mode or a nighttime mode" and "first trace data" and "second trace data."

Because all of these terms were positively recited in originally filed claims, the amendment of those claims did not necessitate any new grounds of rejection.

Moreover, because added claims 26-26 correspond to features recited in claims 1, 11 and 21, the subject matter of claims 26-28 did not necessitate the new grounds of rejection.

Accordingly, because the new grounds of rejection were not necessitated by the claim amendments made in the Amendment filed on July 19, 2004, the finality of the outstanding Office Action is premature and should be withdrawn.

Thus, Applicants respectfully request that the finality of the outstanding Office Action be withdrawn.

Claims 1-5, 9, 11-13, 17 and 26-27 stand newly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 6,046,863 to Chino. This rejection, presented in the previous Office Action regarding claims 1-5, 9, 11-13 and 17 and specifically "maintained" in the outstanding Office Action, is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Applicant incorporates herein the reasons presented above in traversal of the maintained rejection of these claims. Applicant also presents the following un-rebutted arguments in traversal of this new rejection.

First, Chino contains no disclosure of (1) a surveillance camera, (2) how to identify an object of interest to zoom in on or away from in a surveillance

operation; (3) how to track an object of interest to zoom in on or zoom away from in a surveillance operation. The Office Action provides no objective factual evidence to motivate one of ordinary skill in the art to use Chino as a surveillance camera or to replace the fixed focus lens of Beis with the variable focus zoom lens system of Chino, which is not even disclosed to be used as a surveillance camera. Neither reference discloses using a surveillance camera with a zoom lens feature and neither reference discloses a system to make the proposed combination operate properly without further invention.

Second, the Office Action fails to provide objective evidence that one of ordinary skill in the art would desire to modify a fixed focus surveillance camera like that of Beis with a sophisticated autofocus zoom lens system incorporating a neutral density filter. This argument was presented in the amendment filed on July 19, 2004 and remains un-rebutted.

As pointed out above, the mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggested the desirability of the modification.

Further, with respect to claims 4 and 5, Chino does not disclose or suggest daytime and nighttime modes and/or a system designed to switch between a daytime mode and a nighttime mode. In this regard, the Office Action alleges that Chino teaches that the insertion or removal of a filter

corresponds to daytime or nighttime modes. Applicant respectfully submits that this correspondence was not recognized by Chino and that Applicant's disclosure is impermissibly being relied in a hindsight manner upon as a basis for a teaching of such a correspondence.

Further, with respect to claim 4, the Office Action states what the Beis-Chino reference combination teaches. Applicant respectfully submits that this argument begs the question of whether it is proper to modify Beis in view of Chino, as suggested, and that the Office Action has not made out a *prima facie* case that a skilled worker would be properly motivated to modify Beis in view of Chino, for reasons presented above.

Further, regarding claim 11, the Office Action alleges that one of ordinary skill in the art would have loaded the first trace data in a daytime mode and loaded a second trace data in a nighttime mode in order to fix an out of focus condition, referencing Chino, col. 1, lines 28-52. Applicant respectfully disagrees. In col. 1, lines 28-52, Chino never mentions a daytime mode and a nighttime mode and, as pointed out above, never mentions a nighttime mode at all. In fact, in this portion of Chino, the prior art is being discussed, not Chino's invention. In this regard, Applicant respectfully submits that it would not be obvious to revert to the prior art in view of Chino's teaching of the advantages of his system over the prior art.

Moreover, Chino never discusses a daytime mode and/or a nighttime mode of operation, or of using zoom tracking data in such non-disclosed modes, or of limiting use of one type of zoom tracking data at night and a different type of zoom tracking data during the day. This is another reason that these two references teach away from being combined as suggested by the Office Action.

Regarding claim 26, this rejection corresponds to the rejection of claim 1, and is respectfully traversed for the reasons presented above regarding the traversal of the rejection of claim 1.

Regarding claim 27, this rejection corresponds to the rejection of claim 11, and is respectfully traversed for the reasons presented above regarding the traversal of the rejection of claim 11.

Claims 6-8, 10, 14-16 and 18-25 stand rejected newly under 35 U.S.C. §103(a) as unpatentable over Beis in view of Chino, and further in view of U.S. Patent 5,959,669 to Mizoguchi. This rejection is respectfully traversed.

Applicant incorporates herein all of the reasons presented above in traversal of the maintained rejection of these claims.

Applicant also presents the following additional arguments in traversal of

this new rejection.

With respect to claim 6, the Office Action never establishes that Beis has a color image aliasing problem to be corrected, and, thus fails to present objective factual evidence that one of ordinary skill in the art would turn to Mizoguchi to modify the improper Beis-Chino reference combination.

With respect to claim 21, there is no disclosure in either applied reference of relating first trace data to a daylight mode and second trace data to nighttime mode. Presumably, Chino's zoom lens goes in and out of focus only when a filter is inserted into or removed from the lens path, and there is no disclosure of relating the insertion and/or removal of a filter to operation in a daytime or nighttime mode. Chino itself does not disclose inserting and removing an infrared filter under any specific circumstances, and has no disclosure of separate nighttime and daytime modes of operation. In short, there is absolutely no disclosure in either reference of the relationship of the first trace data to a daylight mode and second trace data to nighttime mode or of controlling movement of a lens on the basis of the recited first and second trace data. This is another reason tending to teach away from combining these two references, as suggested.

Regarding claim 28, this rejection corresponds to the rejection of claim 21, and is respectfully traversed for the reasons presented in this Amendment regarding the traversal of the rejection of claim 21.

Accordingly, for the aforementioned reasons, Applicant respectfully submits that the Office Action fails to make out a prima facie case of obviousness of the invention recited in claims 1-28.

Reconsideration and withdrawal of the outstanding rejections of claims 1-028 is respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the

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outstanding Office Action, and as such, the present application is in condition for allowance.

Applicants also respectfully request that the finality of this Office Action be withdrawn for the reasons stated above.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 39,538, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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